

REMARKS

The Examiner has rejected Claims 2-7 and 10-18, all of the claims of the application, under 35 USC 112 for the addition of new matter. The previous Amendment added the language “not strong enough to itself alone hold groceries that would normally fit into the container.” Although applicant believes that the added language is not new matter and is supported by the specification, applicant has deleted this language and substituted the language, directly from the specification, page 13, lines 9-10, “not usable for stand alone paper grocery sacks.”

The Examiner has also rejected Claims 2, 11, and 12 saying that since “plastic grocery sacks analogous to the ones used in grocery stores are made of different base perimeters and collars heights,” it “cannot be determined what base perimeter and collar height dimensions are required by” applicant’s claim language that requires a base perimeter “approximately equal to the base perimeter of the selected size plastic grocery sack” and a “height approximately equal to the height to the collar of the selected size plastic grocery sacks when said selected size grocery sack is opened and expanded.” Applicant’s claim recites “a paper liner for a selected size plastic grocery sack having a base perimeter and collar height.” This clearly indicates that the claim and language therein refers to a “selected size plastic grocery sack.” The claim also defines the selected size grocery sack as having a “base perimeter and collar height.” The later reference to a base perimeter approximately equal to “the base perimeter of the selected size plastic grocery sack” defines the grocery sack as the “selected size grocery sack” which has a base perimeter. Thus, even though plastic grocery sacks as used in grocery stores may have different size base perimeters, the claim is definite in that it is the base perimeter of the selected size plastic grocery sack. A person skilled in the art is directed by the claim to select a particular size plastic grocery sack. Once a particular size plastic grocery sack is selected, then it is clear that the base perimeter is the base perimeter of that particular size plastic grocery sack that has

been selected and the height to the collar is the height to the collar of that same selected plastic grocery sack. The particular limits of the base perimeter and collar height recited in the claim are clear.

The Examiner has rejected Claims 2-7 and 10-18 under 35 USC 103 as being unpatentable over the admitted prior art in view of Rodish or Fowler et al. The admitted prior art is using a standard paper grocery bag or sack as a liner for a standard plastic grocery bag or sack. The Examiner states: “a paper bag whose base and height are ‘approximately equal’ to that of an expanded ‘selected size plastic grocery bag’ is not found.” The Examiner appears to dismiss the difference of the bag being “made of a grade of paper of lighter weight than that used for standard paper grocery bags” as a functional limitation without structural limitation. The Examiner agrees that, for Claims 7 and 13 (Claim 18 also?), the admitted prior art does not show the grade of paper being between 35 and 50 lbs. The Examiner takes the position, however, that the Rodish and Fowler et al. patents show use of paper for bags of between 35 and 50 lbs. and of between 25 and 90 lbs., respectively.

Rodish shows a special pleated paper grocery bag. Rodish’s objective is similar to applicant’s objective in the purpose to reduce the paper usage in regard to paper grocery bags by using lighter weight paper. Rodish says, Col. 1, lines 28-32, “The conventional grocery bag is normally formed from kraft paper stock having a basis weight of about 70 lbs. per ream (3000 sq. ft.), although higher basis weights are sometimes employed to insure adequate bag strength.” Rodish then says, lines 43-46: “Obviously, there is a great economic advantage to be achieved if grocery bags can be fabricated from 40 lb. stock and still afford the same or even greater strength characteristics as 70 lb. stock.” Thus, both Rodish and applicant recognized an economic problem with using the normal 70 lb or greater weight paper and sought to solve the problem by using lighter weight paper to reduce the cost of paper bags. However, Rodish and applicant solved the problem in different ways. Rodish invented a way to make a stronger bag by using a pleated paper construction where the pleats in the paper

strengthen the paper and the bag made from the pleated paper. Thus, the cited Rodish patent shows a pleated paper bag made using 40 lb. paper. Rodish claims that the bag is as strong as the normal paper grocery bag made with 70 lb. or greater weight paper. Applicant has solved the problem in a completely different way by using a lighter weight paper bag of standard, nonpleated construction as a liner in a plastic grocery bag. Rather than having to reinforce the paper bag by using a special pleated construction as taught by Rodish, (or by increasing the bag plys or providing a liner for the paper bag as discussed in the second paragraph, Col. 1, of Rodish) applicant reinforces his lighter weight paper bag by using an outer standard plastic grocery bag to reinforce the lighter weight paper bag. Thus, the lighter weight paper bag becomes a liner for the standard plastic grocery bag. These are very different ways of approaching the same problem.

The cited Rodish patent certainly supports applicant's assertion that standard paper grocery bags or sacks are normally made of 70 lb. or greater weight paper, and that a person skilled in the art would not make a standard paper grocery bag of 40 lb. weight paper. Further, Rodish teaches that the lighter weight paper, lighter than about 70 lb. weight, would not be used in making a standard paper grocery bag without some special reinforcement of the bag, such as the special pleats taught by Rodish. There is nothing in Rodish to suggest using a lighter weight paper bag as a liner in a plastic grocery bag and nothing to suggest using a lighter weight paper bag as a liner for a bag. Rodish does not show or teach a lighter weight paper bag of standard or usual nonpleated paper bag construction. The Rodish patent is directed to a special, pleated bag construction.

Applicant's claims have been amended to indicate that applicant's bag is nonpleated. While nothing in applicant's specification specifically says the bag is nonpleated, there is nothing in the specification or drawings that suggest a pleated bag and the bag is shown in the drawings as a bag of standard nonpleated bag construction.

The Fowler et al. patent shows a machine for registering printed matter in making paper bags, a problem being that it is important that the printed matter appear in approximately the same position on each bag. Fowler et al. merely indicated that the bag making machine can make bags from kraft paper of between 25 and 90 lb. weight. Applicant has never argued that bags are not normally made from lighter weight paper such as 25 to 50 lb. paper, only that normal grocery bags, i.e., bags or sacks for loading with a plurality of grocery items, are not made of such light weight paper. Most stores have small bags made of light weight paper. If a person buys a single or several light weight items, a small, light weight bag will be used. However, if a person buys a number of grocery items, the smaller, light weight bags are not used. A person skilled in the bag manufacturing art or in the grocery packing art, such as baggers and check out clerks, know well what a grocery bag is. Nowhere do Fowler et al. limit use of their equipment to "grocery sacks." All types of sacks can be made on their equipment. Thus, Fowler et al. do not suggest or teach grocery bags made of light weight paper, or suggest or teach a bag of light weight paper of a size to fit into a standard plastic grocery bag that would work as a liner. We have all had some grocery items at times put into smaller, lighter weight paper bags, that are then put into a standard plastic grocery bag, not as a liner, but as one of several items placed, along with the other items, in the plastic grocery bag.

It is submitted that neither Rodish nor Fowler et al., in combination with the admitted prior art, make applicant's lighter weight paper liner for a plastic grocery bag obvious. Fowler et al. do not teach lighter weight bags to fit into grocery bags and Rodish teaches a reinforced, stand alone grocery bag. Applicant's claims are not obvious and should be allowable.

It is further submitted that the language that the sack is made of a grade of paper of lighter weight than that used for standard paper grocery sacks and not usable for stand alone paper grocery

sacks is a structural limitation because it structurally defines a property of the paper from which applicant's sack is made.

Please charge any additional fees that may be due to Deposit Account No. 13-1175 of the undersigned.

Respectfully,

MALLINCKRODT & MALLINCKRODT

A handwritten signature in black ink, appearing to read "Robert R. Mallinckrodt", written in a cursive style.

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